

## **REMARKS**

In the Office Action, the Examiner rejected pending claims 1-3, 5-25, 27-50, 52-54, and 56-58. By this paper, Applicants hereby amend claims 1, 3, 5-16, 19, 22, 25, 27-34, 40, 43, 44, 47-50, 52, 53, 56, 57, and 58. No claims were added or cancelled. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

### **Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-3, 5-25, 27-50, 52-54, and 56-58 under 35 U.S.C. § 103(a) as being unpatentable over Eder (US Patent 6,321,205, hereinafter "Eder"). Applicants respectfully traverse this rejection.

### ***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot

be relied upon to establish a *prima facie* case of obviousness without some *objective reason to modify* the teachings of the reference. See *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01. Similarly, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Lastly, it is improper to combine references when the combination requires substantial reconstruction or redesign of the main reference to arrive at the claimed invention. *In re Ratti*, 123 U.S.P.Q. at 349.

#### ***Features of Independent Claim 1 Missing From Eder***

Claim 1 recites “providing an electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system”. Further, the form is “configured to enable entry of financial data including system operational data for the prospective medical imaging system.” In contrast, the Eder reference fails to teach or suggest an electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a *prospective* medical imaging system.” Nor does Eder teach system operational data for the medical imaging system. Eder discloses *general non-medical* user inputs which define data fields used by software. See col. 18, lines 12-20. The software taught by the Eder reference is directed towards extracting, aggregating and storing transaction

data associated with *intangible* assets. *See*, Eder, col. 8, lines 1-10; col. 5, lines 12-15. Hence, the forms taught by Eder are incapable of accommodating system operational data of a medical imaging system. For example, system operational data include a variety of operational data determined by the medical imaging system's specification, such as operational and maintenance cost, patient throughput, availability, etc. These parameters are specific to a medical imaging system and cannot be covered by the forms provided by Eder. Further, in rejecting the claims, the Examiner pointed out instances in which Eder discloses system operational data. *See*, Office Action, page 2. Applicants contend that no such disclosure appears to be found in the Eder reference. Therefore, Applicants request the Examiner to further clarify where such disclosure exists in the Eder reference. Absent any such disclosure, the rejection of claim 1 cannot stand.

Further, claim 1 recites “analyzing a prospective purchasing option...to obtain the prospective medical imaging system”, based on the financial data of the client “to provide a client-specific financial analysis of the prospective purchasing option.” In contrast, the Eder reference discloses generic purchasing subsystems, wherein “[t]hese systems incorporate worksheets, files, tables and databases...[that] contain information about the company operations and its related accounting transactions.” *See, e.g.*, Eder, col. 12, lines 57-60; *see also* table 6. Thus, the systems disclosed by the Eder reference are not specifically tailored for analyzing a purchase of a system, much less a medical imaging system.

In addition, the Examiner rejected the claims on grounds of intended use as applied to a medical facility. *See* Office Action, page 3. Applicants submit that the rejection cannot stand on such grounds because Eder simply does not disclose a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system, as recited by claim 1. Consequently, the features of claim 1 recited and discussed above are integral with and stem from the medical-imaging-device purchase-analysis form. In view of the foregoing amendments and remarks, the

issue of intended use is moot. For at least these reasons, independent claim 1 and its dependent claims are believed to be allowable over the cited reference.

***Features of Independent Claim 19 Missing From the Cited Combination***

Claim 19 recites an interface, “wherein the interface includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system”. Claim 19 further recites a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging systems.” In stark contrast, Eder is absolutely devoid of an interface which includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system. Similarly, Eder is devoid of a financial report tailored to such systems. *See, generally*, Eder, col. 12, lines 32-67; Figures 1-9C. The cited reference clearly fails to disclose techniques for evaluating client data associated with a medical imaging system. The system disclosed by Eder is incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of *medical* imaging systems. The types of *interfaces* and *financial reports* recited in claim 19 are clearly structured or configured for *evaluating client data of a medical imaging system*, and are not a simple representation of applying the generic business accounting techniques disclosed in Eder to a medical imaging system. Rather, the claimed *interface* and *financial report* denotes types of interfaces and financial reports that are different than any interface or report described in the Eder reference.

Further, in rejecting the claim the Examiner pointed out that the Eder reference discloses the claimed “wherein the projected financial report enables a client to evaluate feasibility of purchasing the desired system.” Office Action, page 5. However, the Examiner does not appear to indicate where such disclosure is found in the Eder reference. The Applicants request the Examiner to specifically indicate where the

claimed subject matter is indicated in the Eder reference. Absent any such disclosure, the rejection of claims 19 is improper and should be withdrawn.

In addition, the Examiner rejected the claim based on grounds of intended use. See Office Action, page 5. Applicants submit that Eder simply does not disclose an interface, wherein the interface includes a medical-diagnostic-device purchase-analysis-form. Therefore, the issue of intended use is irrelevant and should not constitute grounds for rejecting the claim. Accordingly, for at least these reasons, independent claim 19 and its dependent claims are believed to be allowable over the cited reference.

***Features of Independent Claim 34 Missing From the Cited Combination***

Claim 34 recites “providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective medical imaging system” and a form for “entering *client data* relating to the healthcare facility including system operational data of the prospective medical imaging system.” Conversely, the Eder reference does not teach or suggest a *form* for entering of client data related to a healthcare facility and/or a medical imaging system. Instead, as discussed above, Eder provides for forms to extract, aggregate and store transaction data associated with *intangible* assets (not system operational data). Eder, col. 8, lines 1-10; col. 5, lines 12-15.

Independent claim 34 further recites “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system.” The Eder system displays financial forecasts projecting a firm’s growth based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. Eder simply does not disclose returning a pro forma financial report, much less a pro forma financial report to enable a client to evaluate feasibility of a transaction to obtain a medical imaging system. Therefore, for at least these reasons,

independent claim 34 and its dependent claims are believed to be allowable over the Eder reference.

***Features of Independent Claim 43 Missing From the Cited Combination***

Claim 43 recites “an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system”, wherein the entry fields include “a medical *operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction.*” Claim 43 further recites “a revenue field associated with the medical diagnostic system.” In contrast, Eder does not teach or suggest an internet query *form* having data entry *fields* accepting financial data of a medical diagnostic system. Furthermore, Eder clearly does not disclose a *system* for financially analyzing a potential purchase transaction of a prospective medical diagnostic system. Thus, Eder can not teach the related *Internet results page*. Again, Eder instead provides a financial forecast based on option pricing and cash flow analysis. Eder col. 6, lines 25-64.

Further, in rejecting claim 43, the Examiner used an intended use type argument. *See* Office Action, pages 11, 12. However, because Eder is devoid of an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data, such an argument can not stand in rejecting the claim. Therefore, for at least this reason and for those stated above, independent claim 43 and its dependent claims are believed to be allowable over the Eder reference.

***Features of dependent Claim 53 Missing From the Eder***

Claim 53 is directly dependent from claim 1. The claim recites “medical resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.” Again, Applicants

respectfully submit the modalities recited in the above claim are not disclosed or suggested by the Eder and Javit references. More critically, the forms provided by these references are not suitable for providing fields to accept financial data including system operational data of imaging systems, such as MRI, CT, ultrasound or any combination thereof. For at least these reasons, independent claim 53 is believed to be allowable over Eder.

***Request Withdrawal of Rejection***

For these reasons, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

***Improper Combination - Lack of Objective Evidence of Reasons to Combine***

In addition, the Examiner has not shown the requisite motivation or suggestion to modify the cited reference to reach the present claims. As summarized above, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited reference. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner modified the cited reference based, for example, on the *conclusory and subjective statement*, stating that “it would have been obvious to one of ordinary skill in the art to apply the modeling and analyzing business improvement programs thought by Eder to medical imaging financial system operation to enable medical care professionals to use a broad array of assumptions to forecast utilization of medical procedures and estimated revenue per procedure under multiple capitation scenarios and to provide for a more comprehensive and efficient system for financial/management analysis of medical business operations.” Office Action, pages 3-4. Accordingly, Applicants challenge the Examiner to produce objective evidence of the requisite motivation or suggestion to modify the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

**Conclusion**

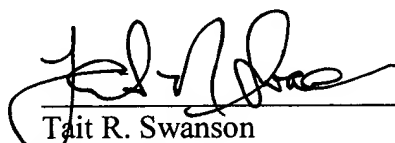
The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

***Authorization for Extensions of Time and Payment of Fees***

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge any fees which may be required, to the Deposit Account No. 07-0845; Order No. GEMS:0122/YOD (15-EC-5773).

Respectfully submitted,

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